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ROPES & GRAY LLP			PASS, NATALIE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,479	Applicant(s) HELITZER ET AL.
	Examiner Natalie A. Pass	Art Unit 3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on **16 July 2008**.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) **23,25,27-31,39,42-44,47 and 50-63** is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) **23,25,27-31,39,42-44,47 and 50-63** is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20080416 & 20080310

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the responses filed 17 July 2008. Claims 23, 39, 47, 54-57 have been amended. Claims 1-22, 24, 26, 32-38, 40-41, 45-46, 48-49 have been previously cancelled. Claims 58-63 have been newly added. Claims 23, 25, 27-31, 39, 42-44, 47, 50-63 remain pending. The Information disclosure statements filed 16 April 2008 and 10 March 2008 have been entered and considered.

Claim Rejections - 35 USC § 112

2. The rejections of claims 23, 25, 27-31, 39, 42-44, 47, 50-57 under 35 U.S.C. 112, first paragraph, are hereby withdrawn due to the amendment filed 17 July 2008.

3. The rejections of claims 54-57 under 35 U.S.C. 112, second paragraph are hereby withdrawn due to the amendment filed 17 July 2008

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23, 25, 27-31, 39, 42-44, 47, 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prendergast et al., U.S. Patent Number 5, 842, 148, in view of Farmer, U.S. Patent Application Publication Number 2004/0139034 for substantially the same reasons given in the prior Office Action (paper number 20080123). Further reasons appear hereinbelow.

(A) The amendments to claims 23, 39, 47, 54-57 appear to have been made merely to correct minor typographical or grammatical errors or to overcome rejections under 35 U.S.C. 112, second paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited amended features are rejected for the same reasons given in the prior Office Action (paper number 20080123), and incorporated herein.

The remainder of claims 23, 39, 47, 54-57 is rejected for the same reasons given in the prior Office Action (paper number 20080123, section 9, pages 5-11), and incorporated herein.

(B) Claims 25, 27-31, 42-44, 50-53 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20080123, section 9, pages 5-11), and incorporated herein.

6. Newly added claims 58-60, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prendergast et al., U.S. Patent Number 5, 842, 148, in view of Farmer, U.S.

Patent Application Publication Number 2004/0139034, and further in view of Bonissone et al., U.S. Patent Application Publication Number 2004/0220837.

(A) As per newly added claims 58-60, Prendergast and Farmer teach a method as analyzed and discussed in claim 39 above.

Prendergast and Farmer fail to explicitly disclose wherein the computer system determines the premium alteration based at least in part on a neural network; a computerized decision tree; and a standard industrial classification code associated with the building structure.

However, these features are well-known in the art as evidenced by Bonissone.

In particular, Bonissone teaches a method

wherein the computer system determines the premium alteration based at least in part on a neural network (Bonissone; paragraphs 51, 65, 58, 162); a computerized decision tree (Bonissone; paragraphs 51, 65, 58, 162); and a standard industrial classification code associated with the building structure

(Prendergast; column 5, line 60 to column 6, line 41, column 6, line 58 to column 7, line 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Prendergast and Farmer to include these limitation, as taught by Bonissone, with the motivations of more accurately making the “determination of the proper premium to cover a given risk” (Bonissone; paragraph [0058]).

The motivations for combining the respective teachings of Prendergast and Farmer are as given in the rejection of claim 23 in the prior Office Action (paper number 20080123) and incorporated herein.

(A) As per newly added claim 63, Prendergast, Farmer and Bonnison teach a method for insuring a building structure by taking into account technologies that militate against loss comprising:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34);

issuing an insurance policy, by an insurance company, covering a building structure that incorporates at least first and second technologies from the plurality of technologies identified in the database (Farmer; paragraph [0001], [0011]-[0012], [0044]), wherein the incorporated technology is capable of outputting data electronically (Prendergast; column 7, lines 17-21) Examiner interprets Prendergast's teachings of "the original collected structural data is preserved in permanent electronic form usable by program 40" to teach a form of wherein the incorporated technology is capable of outputting data electronically;

obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the first and second incorporated technologies (Farmer; paragraph [0026]);

inputting or "capturing" the monitoring data into a computer system (Farmer; paragraph [0026]);

applying a first weighting to data received from the first incorporated technology and a second weighting, different from the first weighting, to data obtained from the second incorporated technology { Bonissone; paragraphs 67, 170-171, 190, 263};

determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data and the first and second weightings (Farmer; paragraph [0026]), { Bonissone; paragraphs 67, 170-171, 190, 263); and

altering the premium of the issued insurance policy based on the determination (Farmer; paragraph [0026]).

The motivations for combining the respective teachings of Prendergast, Farmer and Bonissone are as given in the rejections of claims 23 and 58 in the prior Office Action (paper number 20080123) and above, and incorporated herein.

(B) Newly added claim 62 differs from method claim 63, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss.

System claim 62 repeats the subject matter of claim 63, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 63 have been shown to be fully disclosed by the collective teachings of Prendergast, Farmer and Bonissone in the above rejection of claim 63, it is readily apparent that the system disclosed collectively by Prendergast, Farmer and Bonissone includes the apparatus to perform these functions. As such, these

limitations are rejected for the same reasons given above for method claim 63, and incorporated herein.

7. Newly added claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prendergast et al., U.S. Patent Number 5,842,148, in view of Farmer, U.S. Patent Application Publication Number 2004/0139034, and further in view of German article: Portable structure tester may bring better-built homes, shopping malls, skyscrapers. 1999. [Retrieved on 23 January 2008]. Retrieved from Internet, URL: <http://www.sandia.gov/LabNews/LN01-29-99/aser_story.htm>, hereinafter known as German.

(A) As per newly added claim 61, Prendergast and Farmer teach a method for insuring a building structure by taking into account technologies that militate against loss comprising:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34);

issuing an insurance policy, by an insurance company, covering a building structure that incorporates a technology from the plurality of technologies identified in the database, wherein the incorporated technology is capable of outputting data electronically (Farmer; paragraph [0001], [0011]-[0012], [0044]); (Prendergast; column 7, lines 17-21) Examiner interprets Prendergast's teachings of "the original collected structural data is preserved in permanent electronic form usable by program 40" to teach a form of wherein the incorporated technology is capable of outputting data electronically;

inputting or “capturing” the monitoring data into a computer system (Farmer; paragraph [0026]);

determining, using the computer system, an alteration to a premium for the insurance policy based on the dangerous condition of the building indicated in the monitoring data (Farmer; paragraph [0026]); and

altering the premium of the issued insurance policy based on the determination (Farmer; paragraph [0026]).

Although Prendergast and Farmer teach obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the incorporated technology(Farmer; paragraph [0026]), Prendergast and Farmer fail to explicitly disclose obtaining monitoring data, by the insurance company, indicating a *dangerous* condition of the building, based on data output electronically by the incorporated technology.

German teaches

obtaining monitoring data, by the insurance company, indicating a dangerous condition of the building, based on data output electronically by the incorporated technology (German; page 1, paragraph 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Prendergast and Farmer to include these limitation, as taught by German, with the motivations of “gather[ing] real-world data about the response of typical buildings to high winds and other structural distress ... [and to] ... to help construction contractors, insurance companies, regulatory agencies, and homeowners create

safer, stronger, more secure buildings that might withstand most storms" (German; page 1, paragraph 4).

The motivations for combining the respective teachings of Prendergast and Farmer are as given in the rejection of claim 23 in the prior Office Action (paper number 20080123) and incorporated herein.

Response to Arguments

8. Applicant's arguments filed 17 July 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 17 July 2008.

(A) At pages 11-13 of the 17 July 2008 response, Applicant argues that the claimed features of the application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the newly added features in the 17 July 2008 amendment, have been fully addressed by the Examiner as being obvious in view of the combined teachings of Prendergast, Farmer, Bonisso and German, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20080123), and incorporated herein. In particular, Examiner notes that the limitation of "determining, using the computer system, an alteration to a premium for the insurance policy based on the condition

of the building indicated in the monitoring data,” as recited in amended claim 23, is taught by the combined references. Specifically, Examiner interprets Farmer’s teachings of “a system and method according to an embodiment of the invention, to facilitate acquisition and communication of data to and from a vehicle, providing the ability to monitor and use driving conditions of the vehicle … [...] ... to provide the basis for policy-premium adjustments related to insuring the vehicle. These adjustments could be discounts provided for electing specific monitoring options, or adjustments based on analysis of the data monitored and communicated to the insurance company providing vehicle insurance to the vehicle ... [...] ... such adjustments could be discounts or surcharges based on the analysis of data captured” (emphasis added) (Farmer; paragraph [0026]) together with Farmer’s teachings of “[a] similar approach may be provided for other environments, such as the home, office, other places of business or the like, where a user, other people or the environment may be monitored, data captured and products or services related to the user, others or the environment correlated and communicated in a similar fashion” (Farmer; paragraph [0012]) to teach a form of “determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data.”

As per applicant’s argument on page 11 that “conditions of the vehicle” taught in paragraph [0026] of Farmer does not “relate to the condition of the vehicle itself,” and that “Farmer fails to suggest using this information for insurance purposes,” Examiner respectfully disagrees. Examiner notes that Farmer teaches “effective capturing of vehicle configuration and

operational data for determining possible vehicle insurance premium discounts" (emphasis added) (Farmer; paragraph [0012]) and as well, in paragraph [0026] Farmer teaches "a system and method according to an embodiment of the invention, to facilitate acquisition and communication of data to and from a vehicle, providing the ability to monitor and use driving conditions of the vehicle and/or driver characteristics, to provide the basis for policy-premium adjustments related to insuring the vehicle. These adjustments could be discounts provided for electing specific monitoring options, or adjustments based on analysis of the data monitored and communicated to the insurance company providing vehicle insurance to the vehicle ... [...] ... such adjustments could be discounts or surcharges based on the analysis of data captured" (emphasis added), and Examiner further notes that in paragraph [0028] Farmer teaches that "the communication system 14 may be supplied with data generated by one or more systems or devices to monitor various aspects of the vehicle operation ... [...] ... steering function 32, brake function 34, engine function 36, tires 38 ... [...] ..." (emphasis added) (Farmer; paragraph [0028]); Examiner interprets these teachings to teach the argued limitations.

In the paragraph bridging pages 11-12, Examiner notes that Applicant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

At pages 11-13 of the 16 July 2008 response, Applicant analyzes the applied references separately and argues each of the references individually.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As per Applicant's argument at the pages 12-13 of the 16 July 2008 response that the applied references fail to teach indicating the functional status of the incorporated technology, Examiner respectfully disagrees. Examiner interprets Farmer's teaching of "effective capturing of vehicle configuration and operational data for determining possible vehicle insurance premium discounts" (Farmer; paragraph [0012]) to teach a form of "wherein the monitoring data indicates the functional status of the incorporated technology" as recited in claim 23.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

12. For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
November 6, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686